

REMARKS

Applicant appreciate the Examiner's thorough examination of the subject application and request reconsideration of the subject application based on the foregoing amendments and the following remarks.

Claims 1-10 are pending in the subject application. Claims 1-4 are acknowledged as being allowable by the Examiner.

Claims 5-10 stand rejected under 35 U.S.C. §103.

Claim 2 was amended for clarity (*i.e.*, addition of “portion”) and for grammatical purposes (*i.e.*, addition of “for”).

Claim 5 was amended for clarity and to more distinctly claim Applicant’s invention.

Claim 9 was amended to make clear that the cover portion is being detached from the body portion along the boundary.

Claims 11-23 were added to more distinctly claim embodiments and aspects of the present invention. The amendments to the claims are supported by the originally filed disclosure.

During preparation of the within response Applicant noticed some inconsistencies in terminology within the specification and between the specification and the drawing figures. In addition, Applicant noticed that a reference numeral referred to in the specification was not shown in the drawing figures. As such, Applicant also has amended the specification and the drawing figures to address the foregoing. The amendments to the specification/ drawing figures do not introduce new matter because they either are editorial in nature or are supported by the

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Amendment to the Drawings

The attached sheets of the drawing figures includes changes to Fig 2B. These sheets, which includes Figs. 2A,B, replaces the original nine (9) sheets including the same figures.

originally filed disclosure. As such, entry of the amendments to the specification and drawing figures is respectfully requested.

35 U.S.C. §103 REJECTIONS

Claims 5-10 stand rejected under 35 U.S.C. §103 as being unpatentable over Murata et al. [USP 5,627,587; "Murata"] for the reasons provided on pages 2-4 of the above-referenced Office Action. Applicant respectfully traverses as discussed below. Because claims were amended in the instant amendment, the following discussion refers to the language of the amended claims. However, only those amended features specifically relied upon to distinguish the claimed invention from the cited prior art shall be considered as being made to overcome the cited reference.

Pending (*i.e.*, un-amended) claim 5, claims a video camera including, *inter alia*, a mechanical portion for writing record information onto said recording medium. It is impossible for Murata to disclose, teach or suggest a mechanical portion for writing record information onto said recording medium because the recording medium disclosed in Murata is a solid state recording medium or memory. Electrical signals are transmitted to a memory such as that described in Murata which cause changes in properties of the material making up the memory that are representative of the information or data being stored in the memory. It also should be noted that the grounds for rejection in the above-referenced Office Action also do not identify an

element of the solid-state camera disclosed in Murata that corresponds to the mechanical portion of claim 5.

In addition, the configuration of the solid state camera described in Murata is intended to prevent operation under certain conditions but automatically reinstates operability when the user takes the necessary action to address the concern. For example, if the user opens up the camera to replace the solid-state recording medium/ memory, Murata notes that functionality of the camera is inhibited, however, Murata also is configured so that the opening formed in the camera body can be closed by the user, particularly after the user has inserted a new or refreshed solid state memory. Consequently, Murata does not expressly disclose or teach inhibiting current flow as that term is being used in the subject application, but rather teaches and discloses temporary interruption of current flow until the condition causing such interruption can be overcome by action of the user (*e.g.*, inserting another solid state memory and closing the back cover 22).

Notwithstanding the foregoing, in the interests of advancing prosecution, Applicant amended claim 5 for clarity so as to indicate that the recording medium is a non-solid state recording medium.

As provided in MPEP 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

As provided above, the references cited, alone or in combination, include no such teaching, suggestion or motivation.

Furthermore, and as provided in MPEP 2143.02, a prior art reference can be combined or modified to reject claims as obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally, it also has been held that if the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. Further, and as provided in MPEP-2143, the teaching or suggestion to make the claimed combination and the reasonable suggestion of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As can be seen from the forgoing discussion regarding the disclosures of the cited reference(s), there is no reasonable expectation of success provided in Murata. Also, it is clear from the foregoing discussion that the modification suggested by the Examiner would change the principle of operation of the solid-state camera disclosed in Murata.

As the Federal circuit has stated, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. *Para-Ordance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.2d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995).

It is respectfully submitted that for the foregoing reasons, claims 5-10 are patentable over the cited reference(s) and satisfy the requirements of 35 U.S.C. §103. As such, these claims, as well as the claims dependent therefrom are allowable.

CLAIMS 11-23

As indicated above, claims 11-23 were added to more distinctly claim embodiments of the present invention. These claims are clearly supported by the originally filed disclosure, including the originally filed claims. It also is respectfully submitted that these added claims are patentable over the cited prior art on which the above-described rejection(s) are based.

SEPCIFICATION/ DRAWING AMENDMENTS

As indicated herein during preparation of the within response, Applicant noticed some inconsistencies in terminology within the specification and between the specification and the drawing figures. In addition, Applicant noticed that a reference numeral referred to in the specification was not shown in the drawing figure. The following more specifically describes the amendments to the specification and drawing figures.

The paragraphs starting at lines 6 and 26 respectively on page 6 were revised to be consistent with the legend for reference numeral 6 on Fig. 1 of the subject application.

The paragraph starting at line 4 on page 8 was revised to use reference numeral 6 to identify the cassette eject preventing mechanism as provided in Fig. 1 of the subject application.

The paragraph starting at line 20 on page 8 was revised to use reference numeral 5 to identify the cassette insertion preventing mechanism as provided in Fig. 1 of the subject application.

The paragraph starting at line 6 on page 11 was revised to use reference numeral 5 to identify the cassette insertion preventing mechanism as provided in Fig. 1 of the subject application.

On page 8, reference is made to rotating drum 8 of the mechanical body. Fig. 2B is being amended so as to include this reference numeral. Reference also is made to Figs. 4-5 and the related discussion as further support for the amendment.

It is respectfully submitted that for the foregoing reasons, the specification and the drawing figures satisfies applicable Patent laws and rules and, therefore is considered acceptable.

OTHER MATTERS

Applicant filed an Information Disclosure Statement dated March 14, 2001 in the USPTO, which IDS pre-dates the above-referenced Office Action. A copy of the initialed PTO-1449 included with that IDS was not included with the above-referenced Office Action, although one for a later filed IDS was included with the Office Action. Thus, Applicant respectfully requests that the Examiner reflect their consideration of the earlier filed IDS in the next official communication from the USPTO. Applicant also respectfully requests that the Examiner call the

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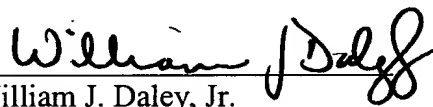
undersigned collect at the below number in the event that the March 2001 IDS has not been received by the Examiner and thus, needs to be again submitted by Applicant.

It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

Because the total number of claims and/or the total number of independent claims post amendment now exceed the highest number previously paid for, a check is enclosed herewith for the required additional fees. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. **04-1105**.

Respectfully submitted,
Edwards & Angell, LLP

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